

REMARKS

The present Supplemental Reply is being filed to clarify the potential relevance of prior art cited against the claims in the Examiner's Office Action dated August 10, 2005 (hereinafter "the Office Action") in the above-identified patent application. In particular, applicants wish to clarify the subject matter disclosed in Thomas et al., *Tetrahedron Letters*, 1999, 40, 403-406 (hereinafter "*Tetrahedron Letters*") and Thomas et al., *J. Med. Chem.*, 1998, 41, 4143-4149 (hereinafter "*J. Med. Chem.*") as well as the reasons that the present claims define over this disclosed subject matter.

In this regard, the Office Action included a rejection of independent Claim 1 and claims dependent thereon as being anticipated under Section 102(b) by formula 3 in *Tetrahedron Letters*. As observed correctly in applicant's Reply of December 8, 2005, the formula 3 compounds represent a genus wherein the substituent R (which corresponds to element R⁶ of applicants' claims) is an alkyl group attached to the core ring nitrogen atom. In distinguishing the pending claims from the compounds of formula 3, applicants called the Examiner's attention to the proviso at the end of pending Claim 1, which requires that when R¹ is OH, W is other than hydrogen, and thus R⁶ in applicant's claims is other than alkyl.

Applicants note that the present claims further define over the *Tetrahedron Letters* formula 3 compounds in that formula 3 compounds are 4 β -methyl-5-(3-hydroxyphenyl)-morphinan compounds. On the other hand, applicants' claims define, *inter alia*, 9 β -methyl-5-(3-hydroxyphenyl)morphinan compounds, which further allow only hydrogen at the 4-position (utilizing the *Tetrahedron Letters* numbering system).

Moreover, applicants note that the present claims also define over the disclosure of 9 β -methyl-5-(3-hydroxyphenyl)morphinan compounds of formulas 1a and 1b in *Tetrahedron Letters*. In this regard, formulas 1a and 1b correspond respectively to 9 β -methyl-5-(3-hydroxyphenyl)morphinan compounds wherein the substituent R (which corresponds to R⁶ of applicants' claims) is a methyl group or a phenethyl group. Based on the aforementioned

proviso, the present claims define over formulas 1a and 1b in that when R¹ is OH, W is other than hydrogen or aryl, and thus R⁶ in applicant's claims is other than alkyl (including methyl) or aryl-substituted alkyl (including phenethyl).

With regard to the *J. Med. Chem.* document, the Office Action included a rejection of applicants' claims in view of formula 5c. See *J. Med. Chem.* at page 4144. In the Reply of December 8, 2005, applicants inadvertently indicated that formula 5c in *J. Med. Chem.* and formula 3 in *Tetrahedron Letters* were equivalent. On further review, and as would be apparent to a person of ordinary skill in the art, formula 5c in *J. Med. Chem.* is instead equivalent to formula 1b in *Tetrahedron Letters*. As discussed above, the present claims define over this compound based on the proviso in independent Claim 1.

The *J. Med. Chem.* document also discloses, *inter alia*, the compound of formula 5b which has the same structure as formula 1a in *Tetrahedron Letters*. In addition, the *J. Med. Chem.* document discloses the compound of formula 5a, which is stereoisomeric to compound 5b at the 4-position of the aforementioned morphan ring. The present claims define over these compounds for the reasons discussed above with regard to formula 1a in *Tetrahedron Letters*.

Based on applicants' Reply of December 8, 2005 and the present supplemental Reply, it is submitted respectfully that there is no disclosure or suggestion in the cited *Tetrahedron Letters* or *J. Med. Chem.* documents of compounds as defined in the present claims. Accordingly, reconsideration and withdrawal of the rejections based on *Tetrahedron Letters* and *J. Med. Chem.* are respectfully requested.

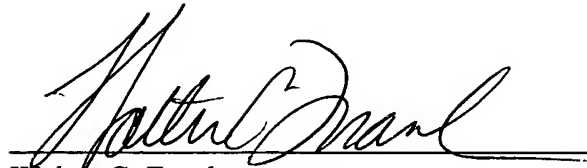
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PATENT

Conclusion

In view of the foregoing and the Reply dated December 8, 2005, an early and favorable reconsideration of the rejections and an allowance of all of pending Claims 1 to 32, 45 to 47, 50 to 59, and 77 to 93 are requested respectfully.

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